

REMARKS

Claims 1-24 are pending in this Application.

Claims 1-24 have been rejected.

Claims 1-24 remain pending in this Application.

Reconsideration of Claims 1-24 is respectfully requested.

I. AMENDMENTS TO THE DRAWINGS

The Applicant has amended Figure 3 of the drawings to correct erroneous reference numerals. Specifically, the video data buffer should have reference numeral 310v instead of 310a, the video decoder control should have reference numeral 315v instead of 315a, and the video decoder should have reference numeral 320v instead of 320a. Similarly, the audio data buffer should have reference numeral 310a instead of 310v, the audio decoder control should have reference numeral 315a instead of 315v, and the audio decoder should have reference numeral 320a instead of 320v. The reference numerals are correctly set forth in the specification. No new matter has been added to the patent application by the amendments to Figure 3.

II. AMENDMENTS TO THE SPECIFICATION

The Applicant has amended the specification to a correct typographical error and an erroneous reference numeral. No new matter has been added to the patent application by the amendments to the specification.

III. REJECTIONS UNDER 35 U.S.C. § 101

On Page 2 of the April 4, 2006 Office Action the Examiner rejected Claims 19-24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Applicant has previously amended Claims 19-24 to recite a “recorded video product” that comprises a plurality of data packets that are embodied in a computer readable storage medium. The Examiner previously withdrew the § 101 rejections in the Advisory Action dated November 8, 2005 but has now renewed the rejection. The Examiner stated that “The claims are directed to a recorded signal, which is non-statutory subject matter.” (April 4, 2006 Office Action, Page 2, Lines 9-10). The Applicant respectfully traverses this assertion of the Examiner. The claims are directed to “a recorded video product embodied in a computer readable storage medium.” The Applicant respectfully submits that Claims 19-24 recite a tangible object and therefore recite patentable subject matter. Accordingly, the Applicant respectfully requests withdrawal of the § 101 rejections.

IV. REJECTIONS UNDER 35 U.S.C. § 112

On Page 2 of the April 4, 2006 Office Action the Examiner rejected Claims 1-12 and Claims 23-24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated, “The independent claims recite that the structure is ‘capable of’ certain actions, but does not require the structure to perform them. ‘Capable of’ is not a positive limitation.” (April 4, 2006 Office Action, Page 2, Lines 17-19). The Applicant respectfully

traverses these assertions of the Examiner. The phrase “capable of” only appears in Claim 1 and in Claim 7.

Claim 1 reads as follows:

1. (Original) An apparatus for implementing special mode playback operations in a digital video recorder, the apparatus comprising:
an Intra frame indexing device capable of receiving an incoming MPEG video stream and identifying therein data packets associated with Intra frames, wherein said Intra frame indexing device modifies header information in a first data packet associated with a first Intra frame to include location information identifying a storage address of a second data packet associated with a second Intra frame. (Emphasis added).

The use of the phrase “capable of” in Claim 1 recites uses/capabilities that are, in point of fact, positive limitations. The same is true of the use of the phrase “capable of” in Claim 7.

The undersigned has performed an on-line Boolean search of the United States Patent and Trademark Office database for United States Patents issued between January 1, 2005 and July 1, 2006 wherein one or more claims included the phrase “capable of.” The search results revealed seventeen thousand seven hundred seventy seven (17,777) issued patents. The Applicant respectfully submits that the use of the phrase “capable of” in a claim is definite. Therefore, the Applicant respectfully requests that the Examiner provide further detail concerning these rejections or, alternatively, withdraw the rejections in their entirety.

V. REJECTIONS UNDER 35 U.S.C. § 103

On Pages 3-8 of the April 4, 2006 Office Action the Examiner rejected Claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,504,585 to Fujinami et al. (hereafter “*Fujinami*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

The April 4, 2006 Office Action asserts that "Regarding claim 1, an Intra frame indexing device capable of receiving an incoming MPEG video stream and identifying therein data packets associated with Intra frames is disclosed in *Fujinami*, figure 13 and column 10, line 66-column 11, line 4 (the entry packet is a packet associated with an I-picture, which is the same as an Intraframe)." For the reasons set forth below, the Applicant respectfully traverses the Examiner's characterization of the teachings of the *Fujinami* reference.

The Applicant respectfully directs the Examiner's attention to the elements of Claim 1:

1. (Original) An apparatus for implementing special mode playback operations in a digital video recorder, the apparatus comprising:
an Intra frame indexing device capable of receiving an incoming MPEG video stream and identifying therein data packets associated with Intra frames, wherein said Intra frame indexing device modifies header information in a first data packet associated with a first Intra frame to include location information identifying a storage address of a second data packet associated with a second Intra frame. (Emphasis added).

The Intra frame indexing device of the present invention identifies data packets associated with Intra frames that are located within the incoming MPEG video stream. The data packets that are identified by the device of the present invention are at all times located within

the MPEG video stream. This is in contrast to the *Fujinami* device. The *Fujinami* device uses special equipment (i.e., video entry point detection circuit 31, entry packet generator 32, multiplexer point E3 in multiplexer circuit 6) to separately create and add a plurality of separate “entry packets” to the MPEG video stream. The separately created and added “entry packets” of the *Fujinami* device are not “data packets” that were originally within the MPEG video stream. Figure 11 of *Fujinami* (and accompanying text) shows that the “entry packets” are separately created in entry packet generator 32 and separately added to the original MPEG video stream by multiplexer circuit 6.

There is no need for a multiplexer circuit in the Applicant’s invention because the Applicant’s invention works directly with the “data packets” that are within the MPEG video stream. “Intra frame indexer 725 detects Intra frames in the MPEG stream and modifies the header information of the data packets before storing the modified data packets to HDD 730 [Hard Disk Drive 730].” (Specification, Page 30, Lines 1-4).

The specially created and added “entry packets” of *Fujinami* are not equivalent to the “data packets” that are within the original MPEG video stream. The Applicant’s device modifies header information within the original “data packets” of the original MPEG video stream. The *Fujinami* device does not do this. The Applicant respectfully reasserts that the *Fujinami* device does not work with original MPEG video stream “data packets” as claimed by the Applicant.

The Examiner stated that, “A first data packet associated with a first Intra frame being modified to include location information identifying a storage address of second data packet

associated with a second Intra frame is disclosed column 12, lines 10-15.” (April 4, 2006 Office Action, Page 3, Lines 7-9). The Applicant respectfully traverses this assertion of the Examiner.

Because the *Fujinami* device does not work with the original “data packets” of the MPEG video stream, it is not correct to say that the *Fujinami* device is modifying a “data packet” when it is modifying one of the specially created and added “entry packets.” The *Fujinami* device modifies an “entry packet” to record distances between the current entry point and the positions of previous entry points (and following entry points when that information is available). The distances between the entry points relate to the location of other “entry packets” that have been (or will be) added to the MPEG video stream by the *Fujinami* device.

The Examiner stated that, “Modifying header information to include location information in a first data packet associated with a first Intra frame is not specifically disclosed in *Fujinami*.” (April 4, 2006 Office Action, Page 3, Lines 9-11). The Applicant agrees that *Fujinami* does not disclose this feature because *Fujinami* does not work with “data packets” as that term is used in the specification and claims of the Applicant’s patent application.

The Examiner then asserts that, “It would have been obvious to one skilled in the art at the time of the invention to put the location information in the header of the packet. The motivation would be to have the location information in an easily accessible portion of the packet.” (April 4, 2006 Office Action, Page 3, Lines 15-17). The Applicant respectfully traverses this assertion of the Examiner.

The Examiner stated that the “entry packet” (i.e., a specially created and added packet) is always located adjacent to the video packet header of the I-picture in the video system and that

“this is equivalent to having the location information in the header of the video packet.” (April 4, 2006 Office Action, Page 3, Lines 11-15). The Applicant respectfully traverses this conclusion of the Examiner.

The “entry packet” has been separately created and added to the MPEG video stream. Placing an “entry packet” that has location information next to a header of a video packet is not equivalent to placing location information within the header of a video packet. The expression “adjacent to the header” does not mean and is not equivalent to the expression “in the header.” In this case, the location information does not even identify “a storage address of a second data packet associated with a second Intra frame.” It simply identifies the location of other entry packets.

The cited portion of *Fujinami* contains absolutely no mention of modifying the header of a “data packet” to include “location information” identifying the “storage location” of another packet as recited in Claim 1.

For these reasons, the April 4, 2006 Office Action fails to establish that the *Fujinami* reference (or the modified *Fujinami* reference) discloses, teaches, or suggests all elements of Claim 1. For the reasons previously set forth, the Applicant respectfully traverses that all of the limitations of Claim 1 are met by *Fujinami* except for the limitation of modifying header information in a first data packet to include location information identifying a storage address of a second data packet. The Applicant has clearly identified and discussed the deficiencies of the *Fujinami* reference.

Furthermore, the supposed motivation set forth in the April 4, 2006 Office Action to “have the location information in an easily accessible portion of the packet” is very general and does not specifically suggest modifying the teachings of the *Fujinami* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to have “easy access” is too general and vague to provide the legally requisite motivation to modify a reference or to combine reference teachings.

The Applicant respectfully submits that one skilled in the art would not attempt to modify the apparatus and method of *Fujinami*. The Applicant submits that a modification of the *Fujinami* apparatus would not operate in the manner of the Applicant’s invention. For this reason, there would be no suggestion or motivation to modify the teachings of the *Fujinami* reference.

Even if the *Fujinami* reference could be modified, the modification would not teach, suggest, or even hint at the Applicant’s invention as set forth in Claim 1. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant’s disclosure. In the present case, a modification of the *Fujinami* reference as suggested by the Examiner would not teach or suggest all the claim limitations of the Applicant’s invention. Therefore, the Applicant respectfully submits that the rejection of Claim 1 under 35 U.S.C. § 103(a) has been overcome.

For the same reasons set forth above with respect to Claim 1, the April 4, 2006 Office Action fails to establish that the *Fujinami* reference (either modified or unmodified) discloses, teaches, or suggests analogous elements of Claims 7, 13, and 19. As a result, the April 4, 2006 Office Action has not established a *prima facie* case of obviousness against Claims 1, 7, 13, and 19 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 1-24.

VI. CONCLUSION

The Applicant respectfully asserts that Claims 1-24 in this Application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.


Respectfully submitted,

MUNCK BUTRUS, P.C.

Date

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Docket Clerk
P.O. Box 802432
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
Email: *wmunck@munckbutrus.com*


William A. Munck
Registration No. 39,308

IN THE DRAWINGS

Please withdraw the current version of Figure 3.

Please add the new corrected version of Figure 3 that is submitted herewith.